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10/816,014	04/01/2004	Raymond B. Ryan	Ryan -PI-04	9572
28710 7590 03/19/2008 PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680				
EXAMINER				
MERCHANT, SHAHID R				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,014

Applicant(s)

RYAN, RAYMOND B.

Examiner

SHAHID R. MERCHANT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 10/26/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 14, 2008 has been entered.

Status of the Claims

2. This action is in response to the request for continued examination filed on January 14, 2008. Claims 1-51 are pending. Claims 1, 3, 5, 6, 9-21, 23-28, 32-37 and 42-51 have been amended.

Response to Arguments

3. Applicant's arguments filed January 14, 2008 regarding ERISA have been fully considered but they are not persuasive. Applicant states that the claims refer to ERISA law in effect on the application's filing date and that the Applicant has explicitly and definitely point out previously. Examiner has reviewed the original disclosure and could not find where Applicant has explicitly and definitely pointed that ERISA is as of the date of filing. Applicant is advised to either remove the references to ERISA or amend the

specification to specifically point out that the ERISA references are explicitly referring to ERISA on the date of filing.

4. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-13, 23, 32-35 and 45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. ERISA is a federal law that has changed several times since being introduced in 1974. Therefore, ERISA is indefinite because it can change over time.

7. Claims 1, 24 and 36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regulation U is a federal law that can change over time. Therefore, it is inappropriate to have the scope of a claim change with time. Since the governments or agencies implementing the rules, regulations and laws meet regularly and have the authority to modify standards, any connection a claim may have to these rules, regulations and laws may have varying scope over time. If the rules, regulations and laws change, the disclosure may no longer support the limitation.

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Regulation U is indefinite because it can change over time. Applicant is advised to either remove the references to Regulation U or amend the specification to specifically point out that the Regulation U references are explicitly referring to Regulation U on the date of filing.

8. Claims 2-23, 25-25 and 37-51 rejected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-20, 24-43 and 46-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al., U.S. Patent No. 6,304,859 (see PTO-1449, Ref. A16).

11. As per claim 1, Ryan teaches computer-implemented method of monitoring sufficiency of collateral for a loan to a non-tax qualified benefit plan, the method comprising the steps of:

receiving a value of collateral for a loan to a non-tax qualified benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security issued by a sponsor of the benefit plan; and

comparing a balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement (see column 6, lines 40-67, column 7, lines 1-17, column 10, lines 12-37, column 13, lines 26-67 and column 14, lines 1-6).

Ryan does not explicitly teach compliance with Regulation U. Compliance to Regulation U is old and well known in the art (as evidenced by Reference "ZF", The Federal Reserve Board, Compliance Guide for Small Entities). One would be motivated to comply with Regulation U because it is a law that requires lenders not to extend credit, secured directly or indirectly by margin stock, in an amount that exceeds the maximum loan value of the collateral securing the credit.

12. As per claim 2, Ryan teaches the method of claim 1 as described above. Ryan further teaches including: signaling an incidence of noncompliance with the loan requirement (see column 7, lines 4-17).

13. As per claim 3, Ryan teaches the method of claim 2 as described above. Ryan further teaches including the step of: computing an amount of the collateral to be sold to retire debt to comply with the loan requirement (see column 7, lines 4-17).

14. As per claim 4, Ryan teaches the method of claim 2 as described above. Ryan further teaches including the step of: computing an amount of additional collateral required to comply with the loan requirement (see column 7, lines 4-17).

15. As per claim 5, Ryan teaches the method of claim 1 as described above. Ryan further teaches wherein the step of comparing includes:

computing an actual ratio of the loan amount divided by the value of the collateral; and

comparing the actual ratio to a test ratio to determine whether to signal noncompliance with the loan requirement (see column 7, lines 4-17).

16. As per claims 6-8, Ryan teaches the method of any one of claims 1-5 as described above. Ryan further teaches wherein the step of receiving a valuation of collateral is carried out with said at least one security. Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Ryan, it is within the basic knowledge of a skilled artisan that several kinds of securities including equity securities, a put contract or a call contract could easily be substituted in place of an insurance policy.

17. As per claims 9-13, Ryan and Ford teach any one of claims 1-5. Ryan further teaches wherein the step of comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral is carried out with the benefit plan being an ERISA-qualified plan (see column 6, lines 40-61).

18. As per claim 14, Ryan teaches a computer-implemented method of illustrating a non-tax-qualified benefit plan's financial performance, the method including the steps of:

receiving non-tax-qualified benefit plan data, the data including a value of collateral for a loan to a non-tax-qualified benefit plan, the loan related to the benefit plan by said loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security issued by a sponsor of the benefit plan, the loan having a balance sufficient for compliance with a Regulation U loan requirement and generating an illustration of said benefit plan's financial performance (see column 6, lines 40-67, column 7, lines 1-17, column 7, lines 18-29, column 10, lines 12-37, column 13, lines 26-67 and column 14, lines 1-6).

19. As per claims 15-19, Ryan teaches the method of claim 14 as described above. Ryan further teaches the following sub-steps: computing the benefit plan's internal rate of return; computing the benefit plan's present value gain or loss; computing the benefit plan sponsor's GAAP cost; and computing the benefit plan sponsor's present value cost; computing a simple accounting rate of return of at least one participant's interest in the benefit plan; computing an internal rate of return of at least one participant's interest in the benefit plan and computing a present value gain or loss of at least one participant's interest in the benefit plan (see column 7, lines 18-29, column 9, lines 66-67 and column 10, lines 1-11). Official Notice is taken that computing the benefit plan's internal rate of return, present value gain or loss, GAAP cost and present value cost is old and well known in the arts.

20. As per claim 20, Ryan and Ford teach the method of any one of claims 14-19 as described above. Ryan further teaches the step of: transferring the financial

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performance data to at least one party with an interest in the benefit plan (see column 7, lines 18-29).

21. As per claim 24, it is in parallel with claim 1 and is rejected for at least the same reason as set forth above.

22. As per claim 25, it is in parallel with claim 2 and is rejected for at least the same reason as set forth above.

23. As per claim 26, it is in parallel with claim 3 and is rejected for at least the same reason as set forth above.

24. As per claim 27, it is in parallel with claim 4 and is rejected for at least the same reason as set forth above.

25. As per claim 28, it is in parallel with claim 5 and is rejected for at least the same reason as set forth above.

26. As per claim 29, it is in parallel with claim 6 and is rejected for at least the same reason as set forth above.

27. As per claim 30, it is in parallel with claim 7 and is rejected for at least the same reason as set forth above.

28. As per claim 31, it is in parallel with claim 8 and is rejected for at least the same reason as set forth above.

29. As per claim 32, it is in parallel with claim 9 and is rejected for at least the same reason as set forth above.

30. As per claim 33, it is in parallel with claim 10 and is rejected for at least the same reason as set forth above.

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31. As per claim 34, it is in parallel with claim 11 and is rejected for at least the same reason as set forth above.

32. As per claim 35, it is in parallel with claim 12 and is rejected for at least the same reason as set forth above.

33. As per claim 36, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

34. As per claim 37, it is in parallel with claim 15 and is rejected for at least the same reason as set forth above.

35. As per claim 38, it is in parallel with claim 16 and is rejected for at least the same reason as set forth above.

36. As per claim 39, it is in parallel with claim 17 and is rejected for at least the same reason as set forth above.

37. As per claim 40, it is in parallel with claim 18 and is rejected for at least the same reason as set forth above.

38. As per claim 41, it is in parallel with claim 19 and is rejected for at least the same reason as set forth above.

39. As per claim 42, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

40. As per claim 43, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

41. As per claim 46, Ryan teaches the methods of claims 1-5, 14, 19, 21 and 22.

Ryan does not explicitly teach wherein a put contract, held by a lender that provides the

loan, accounts for a portion of the collateral held by the benefit plan or a reduction of the loan due to the lender from the benefit plan. Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Ryan, it is within the basic knowledge of a skilled artisan that several kinds of securities including equity securities, a put contract or a call contract could easily be substituted in place of an insurance policy.

42. Claims 47-51 recites similar limitations to claim 46 and thus rejected using the same art and rationale in the rejection of claim 46 as set forth above.

43. Claims 21-23 and 44-45 rejected under 35 U.S.C. 103(a) as being unpatentable over Ford (see PTO-892, Ref. V) in view of Ryan et al., U.S. Patent No. 6,304,859 (see PTO-1449, Ref. A16).

44. As per claim 21, Ford teaches a computer-implemented method of comparing a stock option plan to a non-tax qualified benefit plan, the method including the steps of:

receiving financial performance data for a non-tax qualified benefit plan;
receiving the financial performance data for a stock option plan;
generating a comparison of the stock option plan and the benefit plan data; and
computing at least one difference between the stock option plan and the benefit plan (see pages 60-61 and 65-66).

Ford does not teach the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security issued by sponsor of the benefit plan.

Ryan teaches the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security issued by sponsor of the benefit plan (see column 6, lines 40-67, column 7, lines 1-17, column 10, lines 12-37, column 13, lines 26-67 and column 14, lines 1-6)

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Ford and Ryan to show differences between a stock option plan and a benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

45. As per claim 22, Ford and Ryan teach the method of claim 20 as described above. Ford teaches the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan (see 46-72). Annual reports are shared with shareholder on an annual basis.

46. As per claim 23, Ford and Ryan teach the method of claim 21. Ford further teaches wherein at least one of the steps is carried out with the benefit plan being an ERISA-qualified plan (see 46-72).

47. As per claim 44, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

48. As per claim 45, it is in parallel with claim 23 and is rejected for at least the same reason as set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

/Kambiz Abdi/
Supervisory Patent Examiner, Art
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